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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,214	03/27/2001	Sayori Shimohata	32178-170598	7924
26694	7590	12/17/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP			HAN, QI	
P.O. BOX 34385			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20043-9998			2654	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/817,214

Applicant(s)

SHIMOHATA ET AL.

Examiner

Qi Han

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/27/01</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references listed in the Information Disclosure Statement submitted on 03/27/2001 have been considered by the examiner (see attached PTO-1449).

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A conversation system and method using message translation.

### ***Drawings***

4. The drawings are objected to because in Figs. 20, 24 and 27, item 21, the text term "reseiving" appears to be --receiving--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

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canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-50 and 61-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, antecedent basis of the terms "**the message...**" in line 7 of the claim (also related to the term "said message" in line 10 of the claim) are unclear, because in the parent claim 1 there are three different "**a message**", which causes the claim indefinite. Further, the limitation "said translating apparatus has a judging unit which **judges** whether said message **has been transmitted** from said one terminal apparatus or not **on the basis of** said identification information which **is received** from said one terminal apparatus and **was** added to the message

based on the characters of said one language” is unclear. The examiner is not sure what exact meaning the applicant want to say.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4-6, 10-11, 16-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by TRUDEAU (US 5,987,401).

Regarding **claim 1**, TRUDEAU discloses language translation for real-time text-based conversations (title), comprising:

a network (column 1, line 67);

a server apparatus which transfers a message based on characters through said network (Figs 2 and 4; column 1, lines 15-17, ‘on-line service provider’s host computer (server) which provides the chat service (transfers a message based on characters);

a plurality of terminal apparatuses which perform a conversation by the message based on said characters under the transfer by said server apparatus through said network (Figs 2 and 4; column 1, lines 66-67, ‘supporting multilingual text-based conversations over a network of computers (terminal apparatuses)’); and

a translating apparatus which is connected to said network, receives a message that is transmitted from one of said plurality of terminal apparatuses through said network and based on

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characters of one language, translates the received message based on the characters of said one language into a message based on characters of another language, and transmits the translated message based on the characters of said another language to said server apparatus (column 2, lines 1-8, 'a conversation processor...sending and receiving text-based messages over the network; and a translation control processor, residing in at least one of the computers, for translating a text-based message from a first language to a second language'; column 2, lines 15-23, 'providing an outgoing message (corresponding receiving the message for translating) in user language (one language) from one of the users...; translating the outgoing message ...to the conversation language (another language); transmitting the outgoing (translated) message...to the certain of the computers (through the network)');

wherein said server apparatus transfers said message which is received from said translating apparatus and is based on the characters of said another language to at least one terminal apparatus during a conversation among said plurality of terminal apparatuses (column 6, 'on-line service provider host machine that acts as a server to provide the on line services (such as chat room, which inherently transfer the message) to users' using 'a plurality of client machines (terminal apparatus)').

Regarding **claim 2** (depending on claim 1), TRUDEAU further discloses:

said translating apparatus is provided for one of said plurality of terminal apparatuses (column 2, lines 1-8, 'a translation control processor, residing in at least one of the computers'),

said translating apparatus includes:

a receiving unit which receives the message based on the characters of said one language from said server apparatus (Fig. 3 and column 6, lines 56-58, 'the OSP client process 200

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operates to control on-line conversation service', 'conversation client process 202 operates to process incoming (receiving) ...textural message');

a translating unit which translates the message that was received by said receiving unit and is based on the characters of said one language into the message based on the characters of said another language (Fig. 3 and column 6, lines 56-58, combination of 'translation control process 204', first and second language translator 206 and 208');

a transmitting unit which transmits the message that was translated by said translating unit and is based on the characters of said another language to said server apparatus (Fig. 3 and column 6, lines 56-58, 'the OSP client process 200 operates to control on-line conversation service', 'conversation client process 202 operates to process ... outgoing (transmitting) textural message')

said server apparatus transfers the message which was received from said transmitting unit of said translating apparatus and is based on the characters of said another language (column 6, lines 19-24, 'on-line service provider host machine that acts as a server to provide the on line services (such as chat room, which inherently transfer the message) to users' using 'a plurality of client machines (terminal apparatus)').

Regarding **claim 4** (depending on claim 1), TRUDEAU further discloses said server apparatus transfers the message based on the characters of said one language to the terminal apparatus which does not need the translation during a conversation among said plurality of terminal apparatuses (column 10, lines 21-30, 'determines whether the conference language is the same as the user language', 'then no translation is required').

Regarding **claim 5** (depending on claim 1), TRUDEAU further discloses said server apparatus transfers the message based on the characters of said one language to all of the terminal apparatuses during a conversation among said plurality of terminal apparatuses (as stated above, 'chat room'; column 11, lines 12-14, 'outgoing message will be distribute or sent to all current members of the chat group (conversation)').

Regarding **claim 6** (depending on claim 1), TRUDEAU discloses said server apparatus transfers the message based on the characters of said another language to the terminal apparatus which needs the translation during a conversation among said plurality of terminal apparatuses (as described for claim 1).

Regarding **claim 10** (depending on claim 1), TRUDEAU discloses said translating apparatus has an analyzing unit which analyzes the message based on the characters of said one language in order to discriminate which language said one language is (column 6, lines 62-63, 'the translation control process 204 determines (analyzes) whether a message requires translation and if translation is required, forwards the message to the appropriate (discriminated) language translator', which is read on the claim).

Regarding **claim 11** (depending on claim 1), as best understand in view of the claim rejection under 35USC 112, 2<sup>nd</sup> (see above), TRUDEAU discloses that said plurality of terminal apparatuses have:

a notifying unit which notifies said translating apparatus of a kind of said one language prior to start of a conversation of said one language (Figs. 8A-8D, blocks 'chat language' and 'my language'),

an adding unit which adds identification information for identifying said one terminal apparatus to the message based on the characters of said one language (Figs. 8A-8D and column 11, lines 9-11, 'a message destination specifier 716' that allows to add 'a single user identified in the specifier'),

said translating apparatus has a judging unit which judges whether said message has been transmitted from said one terminal apparatus or not on the basis of said identification information which is received from said one terminal apparatus and was added to the message based on the characters of said one language (column 6, lines 56-59, 'conversation client process 202 operates to process (judge) incoming and outgoing textual message'; Figs. 8A-8D and column 11, lines 9-16, 'a specific member (added member) of the chat group can be designated in the message destination specifier 716 for one-to-one chat', which is read on the claim), and

when said judging unit judges that said message has been transmitted from said one terminal apparatus, said translating apparatus translates the message based on the characters of said one language into the message based on the characters of said another language (column 2, lines 1-8, 'a translation control processor ... for translating a text-based message from a first language to a second language').

Regarding **claim 16**, it recites a translating apparatus. The rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

Regarding **claim 17** (depending on claim 16), the rejection is based on the same reason as described for claim 2, because the claim recites same or similar limitation(s) as claim 2.

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Regarding **claim 19**, it recites a server apparatus. The rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

Regarding **claim 20**, it recites a terminal apparatus. The rejection is based on the same reason as described for claim 1, because the claim recites same or similar limitation(s) as claim 1.

Regarding **claim 21**, it recites a conversation method. The rejection is based on the same reason as described for claims 1 and 5, because the claim recites same or similar limitation(s) as claims 1 and 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRUDEAU.

Regarding **claim 3** (depending on claim 1), TRUDEAU further discloses that said translating apparatus is provided for said server apparatus (column 10, lines 51-64, 'host or server based operations (including translation) are centralized', 'host or server ...providing real-language translation for text-based conversation'). But, TRUDEAU does not specifically disclose "said translating apparatus has a translating unit which translates the message that was

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received from said one terminal apparatus by said server apparatus and is based on the characters of said one language into the message based on the characters of said another language, and said server apparatus transfers the message which was translated by said translating unit and is based on the characters of said another language". However, the similar feature for server based translation operations is well known in the art as evidenced by TRUDEAU himself who teaches that the operations (including translation) of the invention could equally be provided at the host or server machine, and therefor are available to all clients so that each client machine need not include the software or hardware to perform the operations (i.e., real- language translation) (column 10, lines 53-61). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify TRUDEAU for equally providing a server based translation, which has same or similar features as described for client machine (see claim 2), as taught by TRUDEAU, for the purpose of advantaging a centralized translation (TRUDEAU: column 10, lines 57-58).

Regarding **claim 18** (depending on claim 16), the rejection is based on the same reason as described for claim 3, because the claim recites same or similar limitation(s) as claim 3.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRUDEAU as applied to claim 1, and further in view of admitted prior art (the specification: pages 1-2), hereinafter referenced as Admission, and well known prior art (MPEP 2144.03).

Regarding **claim 7** (depending on claim 1), TRUDEAU further discloses a display unit which displays the messages which are based on the characters of said one language, (Figs. 8A-D and column 11, lines 1-16, 'user interface windows (display text-based message) for user'),

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but TRUDEAU does not expressly disclose “said plurality of terminal apparatuses have an adding unit which adds transmission time information indicative of transmission time of the message based on the characters of said one language to said message”. However, this feature is well known in the art as evidenced by Admission who discloses that the conversation windows (Fig.2) display a transmission time, a participant list and a participation possible person list (paragraph 3). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify TRUDEAU for specifically providing and displaying transmission time, as taught by Admission, for the purpose of displaying the progress of the conversation (Admission: page 2, line 1).

Further, TRUDEAU in view of Admission does not disclose said plurality of terminal apparatuses have a **rearranging unit which rearranges the messages** which are transferred by said server apparatus and based on the characters of said one language on the basis of said transmission time information” and displaying the rearranged messages. However, an official notice is taken that the feature of rearranging text-based messages is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify TRUDEAU in view of Admission by specifically providing a mechanism for rearranging text-based messages, for the purpose of flexibly displaying the required information.

Regarding **claim 8** (depending on claim 1), TRUDEAU further teaches that the operations of invention could equally be provided at the host or server machine (column 10, lines 54-55), so that the rejection is based the same reason as described for claim 7, because claim 8 recites same or similar limitation(s) as claim 7, wherein “transfer time information” in claim 8 is equivalently interpreted as “transmission time information” in claim 7.

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Regarding **claim 9** (depending on claim 1), the rejection is based the same reason as described for combining claims 6-7, because the claim recites same or similar limitation(s) as claims 6-7.

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRUDEAU as applied to claim 1, and further in view of CHERNY (US 6,085,162).

Regarding **claim 13** (depending on claim 1), TRUDEAU does not specifically discloses said translating apparatus has a general dictionary suitable for said whole conversation and a dedicated dictionary suitable for a specific conversation in said conversation. However, this feature is well known in the art as evidenced by CHERNY who discloses translation system and method in which words are translated by a specialized dictionary (read on dedicated dictionary) and then a general dictionary (title), comprising a translation system that includes partitions for topical dictionaries 120 (read on dedicated dictionary) and dual-language dictionaries (read on general dictionary) (column 3, lines 48-55). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify TRUDEAU for specifically providing by a specialized dictionary and a general dictionary for the translation, as taught by CHERNY, for the purpose of increasing accuracy for performing translation (CHERNY: abstract).

Regarding **claim 14** (depending on claim 13), TRUDEAU further disclose identifying a conversation group of users of certain of the computers and translating the outgoing message from the user language to the conversation language (column 11, lines 12-39), which means that the specialized (dedicated) dictionary in the combined system can be provided for the group of

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users of the computers, which is read on the claimed “wherein said dedicated dictionary is provided for every plural specific terminal apparatuses among said plurality of terminal apparatuses”.

Regarding **claim 15** (depending on claim 14), the rejection is based on the same reason as described for claim 14, because the claim recites same or similar limitation(s) as claim 14, when all computers are in one user group.

*Allowable Subject Matter*

10. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner’s statement of reasons for allowable subject matter:

Regarding **claim 12**, the instant application is directed to a conversation system. The dependent claim, combining with its parent claim limitations and certain well-known features in the art, identifies the uniquely distinct features of having a translating apparatus comprising: a recording unit which records a history of the translation from the message based on the characters of said one language into the message based on the characters of said another language and a history of the translation from the message based on the characters of said another language into the message based on the characters of said one language; and a charging unit which charges said one terminal apparatus in accordance with said histories recorded in said recording unit. The closest prior art, TRUDEAU (US 5,987,401), CHERNY (US 6,085,162) and

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BEURKET et al. (US 6085162), neither singly nor in combination, specifically disclose nor fairly suggest the above limitation.

The prior art of record provided numerous teachings of alternative techniques and approaches for language translation, including real-time text-based translation used for chat room or conference, multiple users with PCs in network for multiple language translation, translation mechanism resided in client, conversation service server, or proxy server, and using window based interface for the interactive operations for a translation. However, the combined features as stated above, are not anticipated by, nor made obvious over the prior art of the record.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

12. Any response to this action should be mailed to:

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 872-9306, (for informal or draft communications, and please label "PROPOSED" or "DRAFT")

Patent Correspondence delivered by hand or delivery services, other than the USPS, should be addressed as follows and brought to U.S. Patent and Trademark Office, 220 20th Street S., Customer Window, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA, 22202

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (703) 305-5631. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-6954.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh  
December 7, 2004

Donald L. Stern  
PATENT EXAMINER  
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